UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

		Application No.	Applicant(s)
Office Action Summary		09/668,213	WANG ET AL.
		Examiner	Art Unit	
		CRISTINA SHERR	3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 April 2009*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,7-11,13-16 and 18-28* is/are pending in the application.
  4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-4, 7-11, 13-16, and 18-28* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  a)☐ All   b)☐ Some * c)☐ None of:
    1.☐ Certified copies of the priority documents have been received.
    2.☐ Certified copies of the priority documents have been received in Application No. _____.
    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
  Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

1.   This Office Action is in response to Applicant's Amendment filed April 8, 2009.

Claims 1, 7, 13, and 18 are currently amended. Claims 1-4, 7-11, 13-16, and 18-28 are

currently pending in this case.

Continued Examination Under 37 CFR 1.114

2.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 8,

2009 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1-4, 7-11, 13-16, and 18-28, as

currently amended, have been considered but are moot in view of the new ground(s) of

rejection.

Remarks

3.   A recitation directed to the manner in which a claimed apparatus is intended to

be used does not distinguish the claimed apparatus from the prior art- if the prior art has

the capability to so perform. MPEP 2114 and Ex parte Masham, 2 USPQ2d 1647

(1987). In this case, where claim 7 recites "configured to" and "such that" it recites

intended use and thus the cited languages does not further distinguish the claim from

the prior art.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5.   Claims 1-4, 13-16, 18-26, and 27-28 are rejected under 35 U.S.C. §101 because

the claimed invention is directed to non-statutory subject matter. Based on Supreme

Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v.*

Flook, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972);

Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions,

a §101 process must (1) be tied to another statutory class (such as a particular

apparatus) or (2) transform underlying subject matter (such as an article or materials) to

a different state or thing. In addition, the tie to a particular apparatus, for example,

cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir.

2008).

6.   To meet prong (1), the method step should positively recite the other statutory

class (the thing or product) to which it is tied. This may be accomplished by having the

claim positively recite the machine that accomplishes the method steps. Alternatively or

to meet prong (2), the method step should positively recite identifying the material that is

being changed to a different state or positively recite the subject matter that is being

transformed.

7.   In this case, independent claims 1, 13, and 18 recite, inter alia, pushing a

transaction request, receiving, providing information, performing approval an encryption,

etc, without specifying who or what is performing these actions. Further, no material is

being changes to a different state or otherwise being transformed. For this reason,

independent claims 1, 13, and 18 and their dependent claims 2-4, 14-16, and 19-28 are

rejected under 35 U.S.C. 101.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Weinstein (4,453,074)

10.   Regarding claim 7 –

11.   Weinstein discloses a portable electronic authorization device (PEAD) (abs,

"card") for approving a transaction request from a point-of-sale system, the point-of-

sale system storing a user's public key for use in the public key decryption of the

electronic approval, (col 4 ln 16-18, col 9 ln 64-66) comprising:

a transceiver in the portable electronic authorization device configured to receive

first digital data representing the transaction request pushed from an xAgent running on

the point-of-sale system; (col 4 ln 32-34, col 12 63-65)

a display configured to provide information to the user regarding an ability to

approve or modify the transaction request; (col 4 ln 35-40, col 9 ln 64, col 10 ln 4-8) and

a downloadable transaction program to enable the portable electronic

authorization device to perform a approve or modify the transaction request; (col 4 ln

34-36, col 10 42-47,col 12 ln 34-50)

wherein the transceiver is further configured such that when the transaction

request is approved by the user, the transceiver is configured to transmit second digital

data representing the electronic confirmation approval of the transaction request to the

point-of-sale system for decryption utilizing the user's public key, the transceiver being

configured to perform the approval and encrypt the transaction approval being included

within the PEAD and utilizing a private key stored within the PEAD without transmission

of the private key to the remote electronic transaction system or entry of the private key

by the user to the PEAD. (e.g. col 4 ln 32-56, 8 ln 36-59).

12.   Weinstein does not specifically disclose the limitation of a scanner configured to

scan at least one of bar-code or OCR information. However, Official Notice is taken that

barcode scanners are old and well-known, and would provide an economical, quick, and

user-friendly way to read electronic authorizations and certificates. Further, it would be

a predictable result to use such scanners in order to read barcodes and/or OCR

information. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)

13.   Regarding claims 8, 9, and 11 –

14.   As above, Weinstein does not specifically disclose the limitation of a scanner

configured to scan at least one of bar-code or OCR information. However, Official

Notice is taken that barcode scanners are old and well-known, and would provide an

economical, quick, and user-friendly way to read electronic authorizations and

certificates. Further, it would be a predictable result to use such scanners in order to

read barcodes and/or OCR information. *KSR International Co. v. Teleflex Inc.*, 82

USPQ2d 1385 (U.S. 2007).

15.   Regarding claim 10 –

16.   Weinstein does not disclose wherein the transceiver is at least one of an infrared,

a Bluetooth or a wireless receiver. (e.g. col 11 ln 42-52 "wireless")

17.   We note, however, that it is not regarded as inventive to merely make an old

device portable or movable without producing any new and unexpected result. *In re*

Lindberg, 93 USPQ 23 (CCPA 1952).

18.   Claims 1-4, 13-16 and 27-28 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Weinstein (4,453,074) in view of Rothstein (Edward Rothstein (1997,

January 20). Making the Internet come to you, through 'push' technology. New York

Times (Late Edition (east Coast)), p. 5. Retrieved December 7, 2007, from Banking

Information Source database. (Document ID: 10883254).)

19.   Regarding claim 1 –

20.   Weinstein discloses a method for a transaction request from a remote electronic

transaction system running an xAgent to a portable electronic authorization device

(PEAD) (abs, "card") carried by a user for an electronic approval the remote and

transaction system storing a user's public key (col 4 ln 16-18, col 9 ln 64-66) for use in

the public key decryption of the electronic approval, comprising steps of:

sending a transaction request from the xAgent running at the remote electronic

transaction system triggered by a pre-determined event to the PEAD; (e.g. col 4 ln 32-

56)

receiving at the portable electronic authorization device first digital data

representing the transaction request; (col 4 ln 32-34, col 12 63-65)

providing information to the user regarding an ability to approve or modify the

transaction request; (col 4 ln 35-40, col 9 ln 64, col 10 ln 4-8)

performing approval and encryption of the transaction approval request solely

within the PEAD utilizing a private key stored within the PEAD without transmission of

the private key to the remote electronic transaction system or entry of the private key by

the user to the PEAD; (col 4 ln 34-36, col 10 42-47,col 12 ln 34-50) and

when the transaction request is approved by the user, transmitting to the

electronic transaction system second digital data representing the electronic

confirmation approval of the transaction request for decryption utilizing the user's public

key, wherein the receiving step is performed via a communication port associated with

the portable electronic authorization device. (e.g. col 4 ln 32-56, 8 ln 36-59).

21.   Weinstein does not specifically disclose a wireless transaction. We note,

however, that it is not regarded as inventive to merely make an old device portable or

movable without producing any new and unexpected result. *In re Lindberg*, 93 USPQ

23 (CCPA 1952).

22.   Also, Weinstein does not specifically disclose pushing the transaction, i.e., push technology as the manner in which the transaction request is sent. Rothstein, however, does (e.g. par 2-3).

23.   It would be obvious to one of ordinary skill in the art at the time the invention was made to use push technology to make transaction requests since pushing facilitates making money on the internet by guaranteeing sites more visitors and thereby, inter alia, making the sites more appealing to advertisers (see Rothstein, par 6-7).

24.   Regarding claims 2-4 –

25.   Rothstein discloses pushing technology (par 3, "This is being called 'push'..."). Specifically, Rothstein teaches a user automatically receiving information (par 3) via software ("smart") agents (paragraph... "Ultimately...") that are programmed to retrieve information from the internet that meet the user's predetermined criteria (e.g. "information that has been requested" par 7, "requested material" par 6, "user with very specific desires" par 13). Therefore, a predictable result (see, e.g., *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396) of Rothstein would be to apply push technology to retrieving any user information (e.g. stock related, sports, auctions, etc.).

26.   Regarding claim 27 –

27.   Weinstein discloses wherein the approval is carried out based on user identification data saved entirely within the PEAD. (col 4 ln 34-36, col 10 42-47,col 12 ln 34-50)

28.   Regarding claim 28 –

29.   Weinstein discloses wherein the encryption is conducted utilizing the user's

private key. (e.g. col 13 ln 30-40, co 13 ln 1-15).

30.   Regarding claim 13 –

31.   Weinstein discloses a method for xAgent ordering from a remote merchant

server using a portable electronic authorization device carried by a user (abs, "card"),

the remote merchant server storing a user's public key for use in the public key

decryption of the electronic approval (col 4 ln 16-18, col 9 ln 64-66) comprising the

steps of:

receiving at the portable electronic authorization device a first digital data

representing the transaction request from the remote merchant server; (e.g. col 4 ln 32-

56)

providing information to the user regarding an ability to approve the transaction

request; (col 4 ln 35-40, col 9 ln 64, col 10 ln 4-8)

when the transaction request is approved by the user, encrypting transaction

approval data as second digital data representing approval by the user to purchase the

item performing approval and encryption of the transaction approval within the PEAD

utilizing a private key stored within the PEAD without transmission of the private key to

the remote electronic transaction system merchant server or entry of the private key by

the user to the PEAD; (e.g. col 4 ln 32-56, 8 ln 36-59)

and

transmitting the second digital data to the electronic transaction system remote

merchant server to approve the transaction request with the electronic transaction

system the second digital data being decrypted using the public key. (col 4 ln 34-36, col

10 42-47,col 12 ln 34-50)

32.   Weinstein does not disclose triggering xAgent automatic ordering upon user pre-

defined event by pushing a transaction request from the xAgent running on the portable

electronic authorization device to the remote merchant server through entering product

information at the portable electronic authorization device and accumulating the product

information by an xAgent running on the portable electronic authorization device.

33.   Rothstein, however, does disclose pushing technology (par 3, "This is being

called 'push'..."). Specifically, Rothstein teaches a user automatically receiving

information (par 3) via software ("smart") agents (paragraph... "Ultimately...") that are

programmed to retrieve information from the internet that meet the user's predetermined

criteria. Therefore, a predictable result (see, e.g., *KSR*, 127 S.Ct. at 1741, 82 USPQ2d

at 1396) of Rothstein would be to apply push technology to retrieving any user

information (e.g. stock related, sports, auctions, etc.).

34.   It would be obvious to one of ordinary skill in the art at the time the invention was

made to use push technology to make transaction requests since "pushing makes"

facilitates making money on the internet by guaranteeing sites more visitors and

thereby, inter alia, making the sites more appealing to advertisers (see Rothstein, par 6-

7).

35.   Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Weinstein (4,453,074) in view of Rothstein (Edward Rothstein (1997, January 20).

Making the Internet come to you, through 'push' technology. New York Times (Late

Edition (east Coast)), p. 5. Retrieved December 7, 2007, from Banking Information

Source database. (Document ID: 10883254).) further in view of Geer , Jr. et al (US

6,212,634).

36.   Regarding claim 14 –

37.   Weinstein and Rothstein disclose as previously discussed.

38.   Neither Weinstein nor Rothstein disclose wherein the user pre-defined event can

be at least one of a total order exceeding a pre-defined amount of dollars, an end of a

week occurring wherein the xAgent places orders accumulated during the week, and a

bargaining price set by the user being found.   Geer, however, does. (e.g. col 7 ln 20-30,

40-50).

39.   It would be obvious to one of ordinary skill in the art to combine Geer with

Weinstein and Rothstein since all three are in the area of electronic transactions and

smartcard technology and motivated by the need to make stock trading more automatic,

and therefore more easily profitable.

40.   Regarding claim 15 –

41.   Neither Weinstein nor Rothstein disclose wherein the step of entering the product

information includes using the keypad of the portable electronic authorization device to

enter at least one of a product code, product name, manufacturing number, and

quantity. Geer however, does (col 6 ln 58-68, where customer uses computer to choose

a video to download, it would be a predictable result that customer is using the

computer's keyboard to choose the video, since keyboards on computers are old and

well-known. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)).

42.   It would be obvious to one of ordinary skill in the art to combine Geer with

Weinstein and Rothstein since all three are in the area of electronic transactions and

smartcard technology and motivated by the need to make purchases more secure and

convenient.

43.   Regarding claim 16 –

44.   Weinstein, Rothstein and Geer do not specifically disclose the limitation of using

a scanner configured to scan at least one of bar-code or OCR information. However,

Official Notice is taken that barcode scanners that scan barcode information are old and

well-known, and would provide an economical, quick, and user-friendly way to read

electronic authorizations and certificates. Further, it would be a predictable result to use

such scanners in order to read barcodes and/or OCR information. *KSR International Co.*

v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007)

45.   Claims 18-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Weinstein (US 4,453,074) in view of Rothstein (Edward Rothstein (1997, January 20).

Making the Internet come to you, through 'push' technology. New York Times (Late

Edition (east Coast)), p. 5. Retrieved December 7, 2007, from Banking Information

Source database. (Document ID: 10883254)), further in view of Austin et al (US

5,781,708).

46.   Regarding claim 18 –

47.   Weinstein discloses

        establishing communication link between the electronic point of sale transaction

terminal and the portable electronic authorization device; (e.g. col 4 ln 20-30)

receiving at the portable electronic authorization device a first digital data

representing the transaction request; (e.g. col 4 ln 32-56)

providing information to the user regarding an ability to approve the transaction

request; performing approval of the transaction request solely within the PEAD

when the transaction request is approved by the user, encrypting transaction approval

data as second digital data representing approval by the user to purchase the item

utilizing a private key stored within the PEAD without transmission of the private key to

the remote electronic transaction system or entry of the private key by the user to the

PEAD; (col 4 ln 34-36, col 10 42-47,col 12 ln 34-50) and

transmitting the second digital data to the electronic transaction system to

approve the transaction request with the electronic transaction system performing

approval and encryption of the transaction approval utilizing the public key. (col 4 ln 34-

36, col 10 42-47,col 12 ln 34-50)

48.   Weinstein does not specifically disclose pushing a transaction request from the

xAgent running at the remote electronic transaction system triggered by a pre-

determined event or entering product information at the portable electronic device.

49.   Rothstein, however, discloses pushing technology (par 3, "This is being called

'push'..."). Specifically, Rothstein teaches a user automatically receiving information (par

3) via software ("smart") agents (paragraph... "Ultimately...") that are programmed to

retrieve information from the internet that meet the user's predetermined criteria.

Therefore, a predictable result (see, e.g., *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396)

of Rothstein would be to apply push technology to retrieving any user information and

for that user information to include product information entered by the user (e.g. stock related, sports, auctions, etc.).

50.   Also, Weinstein and Rothstein do not disclose printing a receipt at a remote printer. Austin, however, does, at, e.g. col 3 ln 17-57.

51.   It would be obvious to one of ordinary skill in the art at the time the invention was made to use push technology to make transaction requests since "pushing makes" facilitates making money on the internet by guaranteeing sites more visitors and thereby, inter alia, making the sites more appealing to advertisers (see Rothstein, par 6-7). Also, it would be obvious to one of ordinary skill in the art to combine Weinstein and Rothstein with Austin for greater ease in record-keeping.

52.   Regarding claim 19 –

Weinstein discloses the step of encrypting the approval data using a public key cryptography technique using at least a user's private key. (e.g. col 4 ln 32-56, 8 ln 36-59).

53.   Regarding claim 20 –

54.   Weinstein does not disclose the step of entering the product information includes using a keypad of the portable electronic authorization device to enter at least one of a product code, product name, manufacturing number, and quantity. However, as discussed above under Rothstein, it would be a predictable result for product information to be entered by a user via an interface such as a keyboard thus combining push technology with the disclosure of Weinstein. (*KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

55.   Regarding claim 21 –

56.   As above, Weinstein does not specifically disclose the limitation of a scanner

configured to scan at least one of bar-code or OCR information. However, Official

Notice is taken that barcode scanners are old and well-known, and would provide an

economical, quick, and user-friendly way to read electronic authorizations and

certificates. Further, it would be a predictable result to use such scanners in order to

read barcodes and/or OCR information. *KSR International Co. v. Teleflex Inc.*, 82

USPQ2d 1385 (U.S. 2007).

57.   Regarding claim 22 -

58.   Weinstein does not specifically disclose wherein the step of printing the receipt

step includes establishing a connection between the portable electronic authorization

device and the printer. Austin, however, does, at, e.g. col 3 ln 27-40.

59.   Regarding claim 23 –

60.   Weinstein does not specifically disclose the step of establishing a connection

between the portable electronic authorization device and the printer is performed by

entering printer identification information into the portable electronic authorization

device. Austin, however, does, at, e.g. col 8 ln 17-43.

61.   Regarding claim 24 -

62.   Weinstein does not specifically disclose the step of establishing a connection

between the portable electronic authorization device and the printer is performed by

entering subscriber identification information into the printer. Austin, however, does, at

e.g. col 7 ln 44-55.

63.   Regarding claim 25 –

64.   Weinstein does not specifically disclose wherein the step of establishing a

connection between the portable electronic authorization device and the printer is via

infrared.   Austin, however, does, at, e.g., col 6 ln 51-60.

65.   Regarding claim 26 -

66.   Weinstein does not specifically disclose wherein the step of establishing a

connection between the portable electronic authorization device and the printer is via

short range RF. Austin, however, does, at e.g. col 6 ln 54-56.

Conclusion

67.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

68.   Ballard et al (US 2004/0267673) discloses processing of credit card transactions

using internet protocol.

69.   Anderl et al (US 4,882,472) discloses a security file system and method for

securing data in a portable data carrier.

70.   Ginter et al (US 5,892,900) disclose systems and methods for secure transaction

management and electronic rights protection.

71.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to CRISTINA SHERR whose telephone number is

(571)272-6711. The examiner can normally be reached on 8:30-5:00 Monday through

Friday.

72.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Calvin L. Hewitt, II can be reached on (571)272-6709. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

73.   Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

                                                        CRISTINA OWEN SHERR
                                                        Examiner
                                                        Art Unit 3685

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621